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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,145	04/27/2001	Salil Pradhan	30014343 US	7305

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EXAMINER

HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/843,145	Applicant(s) PRADHAN ET AL.	
	Examiner Allan Hoosain	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/27/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8,11-26 are rejected under 35 U.S.C. 102(e) as being anticipated by **Rautila et al.** (US 6,549,625).

As to Claim 1, with respect to Figures 1-4, **Rautila** teaches a method of advertising comprising:

broadcasting a short range advertisement from an advertiser telecommunications device
(Figure 1, labels 12,14);

receiving the broadcast advertisement on a consumer telecommunications device (Figure 1, label 12); and

replying to the advertisement via a broker device interposed in the telecommunications link between the advertiser device and the consumer device (Figure 1, label 26).

As to Claim 2, **Rautila** teaches a method according to claim 1 in which the advertisement is broadcast to a man portable consumer device (Figure 1, label 12).

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As to Claim 3, **Rautila** teaches a method according to claim 2 in which the consumer telecommunications device is a hand-holdable portable and pocketable device (Figure 2).

As to Claim 4, **Rautila** teaches a method according to claim 1 in which the advertisement is broadcast from a man portable advertiser device (Figure 1, label 14).

As to Claim 5, **Rautila** teaches a method according to claim 4 in which the advertiser device is a hand-holdable portable device (Figure 1, label 14).

As to Claim 6, **Rautila** teaches a method according to claim 1 in which the broker device modifies the message sent by the consumer device to the advertiser device, or modifies any follow-up message sent by the advertiser device, or a proxy or master advertising device, to the consumer device (Col. 6, line 60 through Col. 7, line 10).

As to Claim 7, **Rautila** teaches a method according to claim 1 in which the advertiser device does not include its own telecommunications address in its broadcast advertisement (Figure 3 and Col. 6, lines 48-60).

As to Claim 8, **Rautila** teaches a method according to claim 7 in which the advertiser device includes the telecommunications address of the broker device in its advertisement (Col. 6, lines 60-65).

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As to Claim 11, **Rautila** teaches a method according to claim 1 in which the consumer device replies to an advertisement via long range telecommunications (Figure 1, label 42).

As to Claims 12-13, **Rautila** teaches a method according to claim 1 comprising sending information sources (a first part of an advertisement via the short range telecommunications), and advertisement information (a second, longer or larger part of the advertisement via short range telecommunications), the second part of the advertisement being transmitted after the consumer device has screened the first part of the advertisement and communicated with the advertisement broker device or with the advertising device (Col. 6, line 60 through Col. 7, line 10).

As to Claim 14, **Rautila** teaches a method according to claim 1 comprising using a mobile telephone, personal digital assistant, or other small portable electronic devices for both the advertiser device and the consumer device, the devices both having both piconet short range and long range telecommunication capabilities (Col. 6, lines 23-47).

As to Claims 15-17,19-25, with respect to Figures 1-4, **Rautila** teaches a portable telecommunications device comprising a short range piconet receiver, a memory, and a control processor, the control processor being adapted in use to accept at least some advertisements that have been received by the receiver and to send a long range telecommunications reply address obtained from the advertisement to the memory, and the memory being arranged to store long range broker device telecommunications addresses for advertisements that have been accepted

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by the device, and in which the device is arranged so as to be able to contact a remote broker device via long range telecommunications without the user having to key in the broker device address (Col. 7, lines 32-51 and Col. 8, line 63 through Col. 9, line 10).

As to Claim 18, **Rautila** teaches a device according to claim 17 in which the controller of the device is adapted to assess a received message to determine whether the message is of a category of interest, and if so request further details or a fuller message via its piconet channel, and in which the device is adapted to receive requested further details of a fuller message via its piconet channel; and in which the device is adapted to contact a reply address via its long distance telecommunications channel (Col. 9, lines 15-20).

As to Claim 26, **Rautila** teaches the network of claim 22 wherein each the telecommunication devices includes a hybrid telephone (Col. 8, lines 49-52).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to

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the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rautila** in view of **Slettengren et al.** (US 2002/0028674).

As to Claims 9-10, **Rautila** teaches a method according to claim 1 in which:

Rautila does not teach the following limitation:

“the advertisement includes one or more advertisement classification codes which are compared with allowable advertisement codes in an advertisement screening operation by the consumer device”

However, it is obvious that **Rautila** suggests the limitation. This is because **Rautila** teaches permitting a user to pick and choose between different received information in particular broadcast areas (Col. 9, lines 15-20). **Slettengren** teaches a mobile devices which compares received information in particular politeness zones (broadcast areas) (P0031-P0035 and P0056-P0057). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add allowable advertisement capability to **Rautila**'s invention for alerting a user of particular information as taught by **Slettengren**'s invention in order to allow a user to choose how to respond to different information.

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Waters et al. (US 6,535,132) teach sending targeted advertisement to mobile devices.

Liu et al. (US 2002/0077896) teach communicating billboard information to mobile devices.

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:


(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Allan Hoosain
Primary Examiner
11/1/04